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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/080,795	02/22/2002	Fredrik Kamme	PRI-0021 (ORT-1508)	9944

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EXAMINER	
KIM, YOUNG J	

ART UNIT	PAPER NUMBER
1637	

DATE MAILED: 01/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.

EXAMINER	
ART UNIT	PAPER
	01122004

DATE MAILED:

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Commissioner for Patents

Advisory Action	Application No.	Applicant(s)	
	10/080,795	KAMME ET AL.	
	Examiner	Art Unit	
	Young J. Kim	1637	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 January 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires *3* months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☐ The proposed amendment(s) will not be entered because:

   (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: *1-23*.

   Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☐ Other: _____

Continuation of 5. does NOT place the application in condition for allowance because: The rejection of claims 1, 2, 4, 5, 7-14, 16-23 under 35 U.S.C. 102(a) as being clearly anticipated by Linsley et al. (U.S. Patent No. 6,271,002 B1, issued August 7, 2001, filed October 4, 1999), made Final in the Office Action mailed on October 6, 2003 is maintained for the reasons of record. Applicants' arguments received on January 6, 2004 have been fully considered but they are not found persuasive for the following reasons. Applicants argue that Linsley et al. reference fails to teach or suggest a method as defined in any of the pending claims 1-23, in which a second strand of DNA is synthesized by contacting a thermostable DNA polymerase selected from a Markush group of elements with a thermostable RNAse H under conditions conductive to thermostable DNA polymerase activity (page 10, Response). For the purpose of arguments, instant claim 1 is analyzed. Claim 1 of the application requires three sub-steps, (a) through (c), wherein sub-step (a) requires that a first strand cDNA be synthesized from an mRNA in a sample with a reverse transcriptase, and a first primer. Linsley et al., at column 15, beginning at line 46, disclose that a first strand cDNA is synthesized by annealing a first primer to an RNA sample (which inherently includes mRNA) and a reverse transcriptase is added (column 15, line 55), thereby satisfying sub-step (a) of the instant claim. Claim 1, sub-step (b) then requires the step of synthesizing a second strand of cDNA by contacting under conditions conducive to a thermostable DNA polymerase activity, said condition comprising an incubation temperature of from 45 to 80 degree Celsius, wherein the DNA polymerase is selected from a Markush group of polymerases; and a thermostable RNAse H. Linsley et al., at column 16, beginning at line 5, synthesizes the second strand of cDNA via use of E. coli DNA polymerase I (column 16, line 12), Klenow fragment of E. coli DNA polymerase I, or T4 DNA polymerase, thereby satisfying sub-step (b) of the instant claim 1(b). The second strand synthesis of Linsley et al. reference also involves the incubation temperature of 37 degrees Celsius for 45-60 minutes, followed by inactivation of Klenow polymerase at 65 degrees Celsius for 5-10 minutes, which is well within the range claimed by instant claim 1(b). With regard to the addition of RNAse H, Linsley et al. describe that RNAse H could be added to dissociate RNA:DNA heteroduplex, which would be applicable to any incubation needing to remove RNA:DNA heteroduplex, which would form during the sub-step (b) of the instant claim. The production of cRNA from the cDNAs also disclosed by Linsley et al. beginning on column 4, lines 56 to column 5., thereby anticipating the instant claim.
Therefore, as argued above, Linsley et al. do in fact disclose all of the limitation which are argued as being not taught by the Applicants, rendering the claims anticipated and the rejection maintained. The rejection has not been maintained for claims 24 and 26 in view of Applicants' amendment received on January 8, 2004, canceling the rejected claims.

The rejection of claims 3, 6, and 15 under 35 U.S.C. 103(a) as being unpatentable over Linsley et a. (U.S. Patent No. 6,271,002 B1, issued August 20, 2002, filed October 4, 1999) in view of Gu et al. (U.S. Patent No. 6,436,677 B1, issued August 20, 2002, filed March 2, 2000), made Final in the Office Action mailed on October 6, 2003 is maintained for the reasons of record. Applicants' arguments received on January 6, 2004 have been fully considered but they are not found persuasive for the following reasons.
Applicants' arguments drawn to the present rejection is solely dependent on the validity of Linsley et al. reference for the rejection under 35 U.S.C. 102(a). As set forth above, Linsley et al. reference do teach every limitation of the rejected claims, thereby rendering claims 3, 6, and 15 obvious over Gu et al.
The rejection has not been maintained for claim 25 in view of Applicants' amendment received on January 8, 2004, canceling the rejected claim.

The IDS received on November 28, 2003 is acknowledged and a signed copy of its corresponding PTO-1449 is attached hereto. It appears that the reference cited in the IDS is material to the instantly claimed invention. However the rejection is not made in the instant action because the previous rejections have been determined to be proper.

KENNETH R. HORLICK, PH.D
PRIMARY EXAMINER
1/13/04